

REMARKS/ARGUMENTS

Status of the Claims

Claims 1-10, 13, 15, and 17-23 are pending. Of these, Claims 18-19 are presently withdrawn.

Response to Claim Rejections Under 35 USC §103

Claims 1-10, 13, 15, 17 and 20-23 are rejected under 35 USC §103(a) as allegedly being obvious over DeFrees, *et al.*, U.S. Patent No. 7,265,085 in view of Oetke, *et al* (2002) *J. Biol. Chem.* 277(8): 6668-6695. Under 35.U.S.C. §103(c), “(s)ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” Applicants respectfully submit that the requirements of 103(c) are satisfied herein. The provisions of 35 U.S.C. 102 (a) -102(d) are not applicable given the present application’s April 9th, 2003 priority date. Moreover, Patent ‘085 (issued September 4, 2007; published July 22, 2004) and the instant application (serial no. 10/549,528; priority: April 9, 2003) were, at the time the invention of the instant application was made, both subject to obligation of assignment to Neose Technologies, Inc. As such, Patent ‘085 does not constitute prior art against the pending claims.

With the elimination of Patent ‘085, the present rejection rests solely on Oetke *et al*. The Oetke disclosure does not disclose conjugates of water-soluble polymers or methods of making such conjugates, a fact conceded to by the Examiner. *See* pg. 4 of the Office Action dated January 6, 2009. In the post-KSR regime, the requirement that every limitation of a claim be considered against the prior art remains unchallenged and is no less applicable than before. As such, the Examiner’s failure to provide a disclosure for forming the water-soluble polymer conjugates of Claim 1, *i.e.* a reference disclosing every limitation of the pending claims, constitutes a failure to establish a *prima facie* case of obviousness against the present invention. Applicants therefore respectfully request withdrawal of this final rejection pursuant to MPEP 707.07.

Obviousness-Type Double-Patenting Rejections

Claims 1-10, 13, 15, 17 and 20-23 are rejected on the ground of nonstatutory obviousness-type double-patenting as allegedly being unpatentable over claims 1-94 of U.S. Patent No. 7,265,085 in view of Oetke, *et al.*, “Versatile Biosynthetic Engineering of Sialic Acid Analogues,” *J. Biol. Chem.* (2002), pgs. 6668-6695.

Claims 1-10, 13, 15, 17 and 20-23 are rejected on the ground of nonstatutory obviousness-type double-patenting as allegedly being unpatentable over claims 112-214 of U.S. PG Pub. 20080050772 in view of Oetke, *et al.*, "Versatile Biosynthetic Engineering of Sialic Acid Analogues," *J. Biol. Chem.* (2002), pgs. 6668-6695.

Claims 1-10, 13, 15, 17 and 20-23 are rejected on the ground of nonstatutory obviousness-type double-patenting as allegedly being unpatentable over claims 1-155 of U.S. Patent No. 7,297,511 in view of Oetke, *et al.*, "Versatile Biosynthetic Engineering of Sialic Acid Analogues," *J. Biol. Chem.* (2002), pgs. 6668-6695.

Claims 1-10, 13, 15, 17 and 20-23 are rejected on the ground of nonstatutory obviousness-type double-patenting as allegedly being unpatentable over claims 1-113 of U.S. Patent No. 7,226,903 in view of Oetke, *et al.*, "Versatile Biosynthetic Engineering of Sialic Acid Analogues," *J. Biol. Chem.* (2002), pgs. 6668-6695.

Claims 1-10, 13, 15, 17 and 20-23 are rejected on the ground of nonstatutory obviousness-type double-patenting as allegedly being unpatentable over claims 10-32 of U.S. Patent No. 7,214,660 in view of Oetke, *et al.*, "Versatile Biosynthetic Engineering of Sialic Acid Analogues," *J. Biol. Chem.* (2002), pgs. 6668-6695.

Claims 1-10, 13, 15, 17 and 20-23 are rejected on the ground of nonstatutory obviousness-type double-patenting as allegedly being unpatentable over claims 1-107 of U.S. Patent No. 7,179,617 in view of Oetke, *et al.*, "Versatile Biosynthetic Engineering of Sialic Acid Analogues," *J. Biol. Chem.* (2002), pgs. 6668-6695.

Claims 1-10, 13, 15, 17 and 20-23 are rejected on the ground of nonstatutory obviousness-type double-patenting as allegedly being unpatentable over claims 1-94 of U.S. Patent No. 7,173,003 in view of Oetke, *et al.*, "Versatile Biosynthetic Engineering of Sialic Acid Analogues," *J. Biol. Chem.* (2002), pgs. 6668-6695.

Claims 1-10, 13, 15, 17 and 20-23 are rejected on the ground of nonstatutory obviousness-type double-patenting as allegedly being unpatentable over claims 10-94 of U.S. Patent No. 7,157,277 in view of Oetke, *et al.*, "Versatile Biosynthetic Engineering of Sialic Acid Analogues," *J. Biol. Chem.* (2002), pgs. 6668-6695.

Applicants shall consider filing a terminal disclaimer in compliance with 37 CFR 1.321(c) once the claims of the present application are indicated as allowable but for the double patenting issue set forth above.

Appl. No. 10/549,528
Amdt. dated July 6, 2009
Reply to Office Action dated January 6, 2009

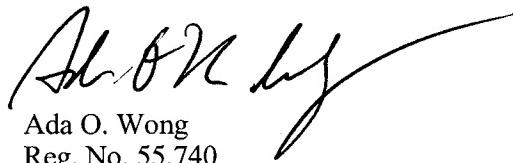
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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-442-1000.

Respectfully submitted,



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